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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/636,039	08/09/2000	Jamey Graham	15358-004240US	5597
20350 7590 12/09/2008 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER CAMPBELL, JOSHUA D				
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2178				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/636,039

Applicant(s)

GRAHAM ET AL.

Examiner

JOSHUA D. CAMPBELL

Art Unit

2178

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-19, 30-38 and 40-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-19, 30-38 and 40-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: Request for continued examination filed 9/23/2008.
2. Claims 11-19, 30-38, and 40-44 are pending in this case. Claims 11, 19, 30, 38, 40, and 41 are independent claims. Claims 11, 19, 30, 38, 40, and 41 have been amended.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 11-19, 30-38, and 40-44 rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for annotating previously define keywords/phrases, does not reasonably provide enablement for "...each annotation visually emphasizes the one or more keywords and related text surrounding the locations of the one or more keywords." The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims. The specification only teaches that annotations are created based on the stored keywords/phrases, while never disclosing any teachings or understanding of the idea of emphasizing related text (not including stored keywords) surrounding the locations of the keywords. In order to expedite prosecution the examiner will interpret the claims as though the amendment

was properly enabled. However, this does not remove the requirement for proper correction by the applicant in the form of either (a) pointing out specifically where this limitation is taught in the specification or (b) properly amending the claims to remove any deficiently enabled limitations.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 11-14, 17 18, 30-33, 36, 37, and 40 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Acrobat Reader (hereinafter Acrobat, Adobe Acrobat Reader, published in 1999) in view of Hart et al. (hereinafter Hart, US Patent Number 5,546,502, issued August 13, 1999) further in view of Nathan et al. (hereinafter Nathan, US Patent Number 6,326,957, filed January 29, 1999).

In regard to independent claim 11, Acrobat discloses a method in which a document is accessed and a section of that document is shown in a first area and thumbnails of the document are displayed in a second area (Page 1-3 of Acrobat). Acrobat also discloses a method in which information about the contents of a document; including dimensions and locations of items (coordinates) are determined, in order to correctly place the information in the thumbnail representation (Page 1-3 of Acrobat). Acrobat also discloses that the portion of the thumbnail window corresponding to the part of the document being displayed is highlighted (emphasized) and changed dynamically as the portion that is viewed is changed to a different portion (Page 1-4,

items 1-4 of Acrobat, the box in the thumbnail changes based on the portion being viewed). Acrobat discloses a method in which determining information about a document (coordinates and dimension) includes determining information about text, forms, graphics, images, and links (Pages 1-5 of Acrobat).

Acrobat does not disclose a method in which the user selects from plurality of concepts rather than entering a query, the concepts having keywords associated with them. However, Hart discloses a method in which a user selects concepts (symptoms) and the system searches for the concepts and commonly known keywords (faults) associated with the concepts in the document and presents the sections of the document that deal with the concepts and text patterns (one keyword and other related text – additional keywords) associated with the concepts (symptoms and faults) out to the user (column 3, line 39-column 4, line 61 of Hart). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Acrobat with the query-free teachings of Hart because it would have provided relevant documentation for the current context more efficiently without the user having to formulate a query and wait for results (column 6, lines 31-44 of Hart).

Acrobat also does not disclose dynamically changing the contents of the single thumbnail image to reflect a change in the contents of the document. However, Nathan teaches dynamically maintaining thumbnail images to keep them concurrent with the document they represent by dynamically updating the content of the image to any change, which would include annotations (column 6, lines 14-18 of Nathan et al.). It would have been obvious to one of ordinary skill in the art at the time the invention was

made to have combined the teachings of Acrobat with the teachings of Nathan because it would have allowed the thumbnail image to correctly represent the most current state of the document regardless of any changes made.

In regard to dependent claim 12, Acrobat discloses a method in which information about the contents of a document; including dimensions and locations of items (coordinates) are determined, in order to correctly place the information in the thumbnail representation (Page 1-3 of Acrobat).

In regard to dependent claim 13, Acrobat discloses a method in which the thumbnail sizes can be changed to a different reduction level (reduction ratio) and the content still correctly corresponds to the original document (Page 1 and 5, items 1 and 5 of Acrobat).

In regard to dependent claim 14, Acrobat does not disclose a method in which the selects from plurality of concepts rather than entering a query, the concepts having keywords associated with them. However, Hart discloses a method in which a user selects concepts (symptoms) and the system searches for the concepts and commonly known keywords (faults) associated with the concepts in the document and presents the sections of the document that deal with the concepts and text patterns associated with the concepts (symptoms and faults) out to the user (column 3, line 39-column 4, line 61 of Hart). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Acrobat with the query-free teachings of Hart because it would have provided relevant documentation for the

current context more efficiently without the user having to formulate a query and wait for results (column 6, lines 31-44 of Hart).

In regard to dependent claim 17, Acrobat discloses a method in which determining information about a document (coordinates and dimension) for creating thumbnail representations of the document incorporate all formatting of that document (Pages 1-5 of Acrobat).

In regard to dependent claim 18, Acrobat discloses a method in which determining information about a document (coordinates and dimension) includes determining information about text, forms, graphics, images, and links (Pages 1-5 of Acrobat).

In regard to independent claim 30 and dependent claims 31-33 and 36-37, the claims incorporate substantially similar subject matter as claims 11-14 and 17-18. Thus, the claims are rejected along the same rationale as claims 11-14 and 17-18.

In regard to independent claim 40, the claim incorporates substantially similar subject matter as claim 11. Thus, the claim is rejected along the same rationale as claim 11.

7. Claims 15, 19, 34, 38, and 41-43 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Acrobat Reader (hereinafter Acrobat, Adobe Acrobat Reader, published in 1999) in view of Nielsen (US Patent Number 6,339,437, filed on September 30, 1997) further in view of Hart et al. (hereinafter Hart, US Patent Number 5,546,502, issued August 13, 1999) and further in view of Nathan et al. (hereinafter Nathan, US

Patent Number 6,326,957, filed January 29, 1999, cited by the examiner in PTO-892 mailed on 12/15/2006).

In regard to dependent claim 42, Acrobat does not disclose that text entities are annotated according to style information if they are relevant to any of a plurality (first and second) of concepts. However, Nielsen discloses a method in which a document is accessed and it is searched to identify text patterns that are relevant to user queries (plurality of concepts), which are received from the user (column 1, line 17-column 2, line 16 of Nielsen). Nielsen discloses a method in which search terms are supplied via user queries and a document is searched to identify text patterns that match those search terms (column 1, line 17-column 2, line 16 of Nielsen). The text patterns that match the queries are then marked using tags and highlighted with color (annotated) to emphasize their position as the document is viewed (column 1, line 17-column 2, line 16 of Nielsen). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of viewing a document by Acrobat with the method of searching a document by Nielsen because it would have provided a user with a simple way to search and identify terms when viewing a document.

In regard to dependent claim 15, Acrobat discloses a method in which the thumbnail representations of the document incorporate all formatting of that document which would include highlighted text entities (Pages 1-5 of Acrobat).

In regard to independent claim 19, Acrobat discloses a method in which a document is accessed and a section of that document is shown in a first area and thumbnails of the document are displayed in a second area (Page 1-3 of Acrobat).

Acrobat also discloses a method in which information about the contents of a document; including dimensions and locations of items (coordinates) are determined, in order to correctly place the information in the thumbnail representation (Page 1-3 of Acrobat). Acrobat also discloses that the portion of the thumbnail window corresponding to the part of the document being displayed is highlighted (emphasized) and changed dynamically as the portion that is viewed is changed to a different portion (Page 1-4, items 1-4 of Acrobat, the box in the thumbnail changes based on the portion being viewed).

Acrobat does not disclose that text entities are annotated according to style information if they are relevant to any of a plurality of concepts. However, Nielsen discloses a method in which a document is accessed and it is searched to identify text patterns that are relevant to user queries (plurality of concepts), which are received from the user (column 1, line 17-column 2, line 16 of Nielsen). Nielsen discloses a method in which search terms are supplied via user queries and a document is searched to identify text patterns that match those search terms (column 1, line 17-column 2, line 16 of Nielsen). The text patterns that match the queries are then marked using tags and highlighted with color (annotated) to emphasize their position as the document is viewed, in a manner that is independent of a second query being made (column 1, line 17-column 2, line 16 of Nielsen). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of viewing a document by Acrobat with the method of searching a document by Nielsen because it

would have provided a user with a simple way to search and identify terms when viewing a document.

Neither Acrobat nor Nielsen disclose a method in which the selects from plurality of concepts rather than entering a query, the concepts having keywords associated with them. However, Hart discloses a method in which a user selects concepts (symptoms) and the system searches for the concepts and commonly known keywords (faults) associated with the concepts in the document and presents the sections of the document that deal with the concepts and text patterns (one keyword and other related text – additional keywords) associated with the concepts (symptoms and faults) out to the user (column 3, line 39-column 4, line 61 of Hart). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Acrobat and Nielsen with the query-free teachings of Hart because it would have provided relevant documentation for the current context more efficiently without the user having to formulate a query and wait for results (column 6, lines 31-44 of Hart).

Acrobat also does not disclose dynamically changing the contents of the single thumbnail image to reflect a change in the contents of the document. However, Nathan teaches dynamically maintaining thumbnail images to keep them concurrent with the document they represent by dynamically updating the content of the image to any change, which would include annotations (column 6, lines 14-18 of Nathan et al.). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Acrobat with the teachings of Nathan because

it would have allowed the thumbnail image to correctly represent the most current state of the document regardless of any changes made.

In regard to dependent claims 34 and 43, the claims incorporate substantially similar subject matter as claims 15 and 42. Thus, the claims are rejected along the same rationale as claims 15 and 42.

In regard to independent claims 38 and 41, the claims incorporate substantially similar subject matter as claim 19. Thus, the claims are rejected along the same rationale as claim 19.

8. Claims 16 and 35 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Acrobat Reader (hereinafter Acrobat, Adobe Acrobat Reader, published in 1999) in view of Nielsen (US Patent Number 6,339,437, filed on September 30, 1997) further in view of Hart et al. (hereinafter Hart, US Patent Number 5,546,502, issued August 13, 1999), further in view of Nathan et al. (hereinafter Nathan, US Patent Number 6,326,957, filed January 29, 1999, cited by the examiner in PTO-892 mailed on 12/15/2006), and further in view of Okamoto et al. (hereinafter Okamoto, US Patent Application Publication Number 2002/0065814, US Filing date June 30, 1999).

In regard to dependent claim 16, none of Acrobat, Nielsen, Hart, or Nathan disclose a method in which the style information relevant to a concept is modified and in response all entities that correspond to that concept are changed to correspond with the new style information. However, Okamoto discloses a method in which a concept tag number, which corresponds to one of a plurality of concepts, is directly associated with

a specific style (page 12, paragraph 0270-0276 of Okamoto). When that style information is changed all tags corresponding to the tag number associated with that style information will reflect that change (page 12, paragraph 0270-0276 of Okamoto). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of viewing a document by Acrobat with the method of searching a document by Okamoto because it would have provided a user with a simple way to search and customize the identification of terms when viewing a document.

In regard to dependent claim 35, the claim incorporates substantially similar subject matter as claim 16. Thus, the claim is rejected along the same rationale as claim 16.

Response to Arguments

9. Applicant's arguments with respect to claims 11-19, 30-38, and 40-44 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent Number 6,564,250

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA D. CAMPBELL whose telephone number is (571)272-4133. The examiner can normally be reached on M-F (7:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joshua D Campbell/
Primary Examiner, Art Unit 2178
December 2, 2008